

**REMARKS/ARGUMENTS**

Upon entry of the present amendment, the Abstract will have been replaced, and claims 17-18, 20, 24, 28-30, and 33 will have been amended, with claims 17-35 remaining pending for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for indication of the allowability of claims 19, 23, and 27.

Turning to the merits of the action, the Examiner has objected to the Abstract of the Disclosure because of a misspelling. By the present amendment, Applicant has amended the Abstract of the Disclosure to correct the misspelling as well as another misspelling. Thus, Applicant respectfully requests that the Examiner withdraw the objection.

The Examiner has rejected claims 17, 18, 21, 24-26, 28-31, and 33-35 under 35 U.S.C. § 102 (e), as being anticipated by YOSHIDA et al. (U.S. Patent No. 6,801,546). The Examiner has also rejected claims 20 and 21 under 35 U.S.C. § 103 (a), as being unpatentable over YOSHIDA et al. (U.S. Patent No. 6,801,546). The Examiner has further rejected claims 20 and 21 under 35 U.S.C.

§ 103 (a), as being unpatentable over YOSHIDA et al. in view of WOLF (U.S. Patent No. 6,535, 303).

As noted above, Applicant has amended claims 17-18, 20, 24, 28-30, and 33. In view of the herein-contained remarks, Applicant respectfully traverses the above rejection, based on the pending claims 17-18, 20-22, 24-26, and 28-35, and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter, but do not narrow the scope of the claims.

Applicant's independent claim 17 generally relates to an image communication apparatus which has a receiver configured to receive image data from a transmitting facsimile apparatus via public switched phone network, and has a printer configured to print the received image data. The claimed image communication apparatus further has a memory which pre-stores an e-mail address of a predetermined management center. The claimed image communication apparatus has a controller which converts the image data received from the transmitting facsimile apparatus into data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to the predetermined management center, based on the pre-stored e-mail address of the predetermined management center. The claimed management center manages information that the image communication apparatus receives and further is configured to connect to the image communication apparatus via the Internet. The transmitting e-mail comprises the same image data as the

received image data printed by the printer. Claim 28 generally recites a related method.

Applicant's independent claim 24 generally relates to an image communication apparatus which has a facsimile transmitter configured to transmit image data to a destination based on a facsimile protocol. The claimed image communication apparatus further has an e-mail transmitter which converts the image data transmitted by the facsimile transmitter into data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to a management center. The claimed management center manages image data that is transmitted by the facsimile transmitter and further is configured to connect to the image communication apparatus via the Internet. The claimed e-mail transmitted by the e-mail transmitter corresponds to the image data transmitted by the facsimile transmitter. Claim 33 generally recites a related method.

With respect to the Examiner's rejection of claims 17 and 28 under 35 U.S.C § 102 (e), in YOSHIDA et al., to the contrary, in order for the facsimile machine 1-17 to transmit image data to a facsimile machine 1-13, as shown in Fig.1, the facsimile 1-17 first transmits the image data to an electronic mail facsimile machine 1-2 via a PSTN or an ISDN 1-18, the electronic mail facsimile machine 1-2 next transmits the image data to an electronic mail facsimile machine 1-11 via the Internet, and the electronic mail facsimile machine 1-11 then transmits the image data to the facsimile machine 1-13 via a PSTN or an ISDN. With such a configuration, the facsimile machine 1-17 of YOSHIDA et al.

sets, in an sub-address, a telephone number of the facsimile machine 1-13 and an e-mail address of the electronic mail facsimile machine 1-11 and transmits the sub-address to the electronic mail facsimile machine 1-2 (col.11, lines 26-54, Fig.4, Fig.6, and Fig.7). Thus, the electronic mail facsimile machine 1-2 of YASHIDA et al. (image communication apparatus identified by the Examiner) does not pre-store the e-mail address of the electronic facsimile machine 1-11 (management center as identified by the Examiner), as claimed in claims 17 and 28.

With respect to a non-limiting embodiment shown in Fig.8, the specification of the present invention states that "According to the above-configured IFAX 1 automatically duplicates all of the transmitted and received e-mail, IFAX mail, and facsimile data, and transmits them to the file server 9 of the center 8" (page 12, line 23 to page 13, line 1). Thus, the image communication apparatus comprises a memory which pre-stores an e-mail address of the predetermined management center. In the other words, in the present invention, the e-mail address of the predetermined management center is not transmitted by the transmitting facsimile apparatus, but is pre-stored in the claimed image communication apparatus.

However, YOSHIDA et al. do not disclose or even suggest that the electronic mail facsimile machine 1-2 pre-stores any e-mail address at all.

Rather, YOSHIDA et al. expressly disclose that the facsimile apparatus machine 1-17 transmits, to the electronic mail facsimile machine 1-2, the e-mail address of the electronic mail facsimile machine 1-11. In other words, YOSHIDA

et al. relay the image data to electronic mail facsimile machine 1-11 only when the e-mail address of the electronic mail facsimile machine 1-11 is set in the sub-address. Thus, independent claims 17 and 28 are clearly distinguished over YOSHIDA et al.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 17 and 28 are not disclosed in YOSHIDA et al., and it is requested that the Examiner withdraw the rejection of these claims, as well as the claims dependent therefrom.

Regarding the rejection of independent claims 24 and 33, in YOSHIDA et al., the facsimile machine 1-17 first transmits image data to the electronic mail facsimile machine 1-2, and the electronic mail facsimile machine 1-2 next transmits the image data to the electronic mail facsimile machine 1-11.

However, YOSHIDA et al. do not disclose the facsimile machine 1-17 which transmits image data to a destination based on a facsimile protocol and transmits, to a management center, an e-mail corresponding to the image data. YOSHIDA et al. also do not disclose the electronic mail facsimile machine 1-2 which transmits image data to a destination based on a facsimile protocol and transmits, to the management center, an e-mail corresponding to the image data.

Rather, YOSHIDA et al. disclose the facsimile machine 1-17 which transmits image data to the electronic mail facsimile machine 1-2 (which the Examiner has determined to be equivalent to a destination) based on a facsimile protocol, but does not transmit, to the electronic mail facsimile machine 1-11

(which the Examiner has determined to be equivalent to the management center), an e-mail corresponding to the image data. YOSHIDA et al. also disclose the electronic mail facsimile machine 1-2 which does not transmit image data to the facsimile machine 1-13 or 1-14 (which the Examiner has determined to be equivalent to a destination) based on a facsimile protocol, but rather transmits, to the electronic mail facsimile machine 1-11 (which the Examiner has determined to be equivalent to the management center), an e-mail corresponding to the image data, as claimed in claims 24 and 33.

Thus, YOSHIDA et al. do not disclose any machine which transmits image data to a destination, based on a facsimile protocol, and further transmits, to a management center, an e-mail corresponding to the image data transmitted based on the facsimile protocol.

On the other hand, the image communication apparatus of the present invention transmits image data to a destination based on a facsimile protocol and transmits, to the claimed management center, an e-mail corresponding to the image data transmitted by the facsimile transmitter, as substantially claimed in Applicant's independent claims 24 and 33. Thus, independent claim 24 and 33 are clearly distinguished over YOSHIDA et al.

Therefore, it is respectfully submitted that at least the features recited in Applicant's independent claims 24 and 33 are not disclosed in YOSHIDA et al., and it is requested that the Examiner withdraw the rejection of these claims, as well as the claims dependent therefrom.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 17, 24, 28, and 33 and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102.

With respect to the Examiner's rejection of claims 20 and 30 under 35 U.S.C. § 103 (a), Applicant's independent claim 20 generally relates to an image communication apparatus which has a scanner configured to scan image data and a panel configured to input an address of a destination. The claimed image communication apparatus has a controller which converts the scanned image data into data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to both of the destination input by the panel and a management center. Further, the e-mail is independently transmitted to the destination (i.e., without passing through the management center). The claimed management center manages information that the image communication apparatus transmits to the destination input by the panel and further is configured to connect to the image communication apparatus via the Internet. The claimed management center is distinct from the destination input by the panel. Claim 30 generally recites a related method.

To the contrary, YOSHIDA et al. do not disclose the facsimile machine 1-17 which independently transmits an e-mail corresponding to scanned image

data to each of the destination input by the panel and a management center. YOSHIDA et al. also do not disclose the electronic mail facsimile machine 1-2 which independently transmits an e-mail corresponding to the scanned image data to each of the destination input by the panel and a management center.

Rather, YOSHIDA et al. disclose the facsimile machine 1-17 which transmits an e-mail corresponding to scanned image data to the electronic mail facsimile machine 1-2 (which the Examiner has determined to be equivalent to the destination input by the panel), but does not transmit it to the electronic mail facsimile machine 1-11 (which the Examiner has determined to be equivalent to the management center). YOSHIDA et al. also disclose the electronic mail facsimile machine 1-2 which does not transmit an e-mail corresponding to the scanned image data to the facsimile machine 1-13 or 1-14 (which the Examiner has determined to be equivalent to the destination input by the panel), but transmits it to the electronic mail facsimile machine 1-11 (which the Examiner has determined to be equivalent to the management center). In other words, in YOSHIDA et al., image data transmitted by facsimile machine 1-17 is merely transmitted to electronic mail facsimile machine 1-2 and is further transmitted to electronic mail facsimile machine 1-11 via electronic mail facsimile machine 1-2. Thus, in YOSHIDA et al., the image data transmitted by facsimile machine 1-17 is not transmitted to electronic mail facsimile machine 1-11 without passing through electronic mail facsimile machine 1-2.

On the other hand, the invention of claims 20 and 30 independently transmits the e-mail to the destination and the management center. In other



words, the e-mail directed to the destination is transmitted to the destination without passing through the management center. Thus, independent claims 20 and 30 are clearly distinguished over YOSHIDA et al.

Further, with respect to the Examiner's assertion regarding YOSHIDA et al., that "it would have been obvious to one of ordinary skill in the art to use the electronic mail facsimile machine (1-2 or 1-11) as the originating facsimile apparatus (1-17)" and "it would have been obvious to one of ordinary skill in the art to send the scanned image data for the relay facsimile transmission straight from electronic mail facsimile", Applicant submits that this assertion is entirely without support and requests that the Examiner cite at least one reference in support of this assertion (together with a proper motivation to combine it with YOSHIDA et al.), if the Examiner chooses to maintain this rejection.

Therefore, it is respectfully submitted that at least the above noted features as recited in Applicant's independent claims 20 and 30 are neither anticipated nor suggested by YOSHIDA et al. The pending claims are submitted to also be patentable over the Examiner's proposed reference, since YOSHIDA et al. do not disclose the unique combination of features recited in Applicant's independent claims 20 and 30.

Nevertheless, with respect to the Examiner's rejection of the dependent claims, since corresponding claims 21-22 and 31-32 are dependent from an allowable independent claim, which is allowable for at least the reasons discussed *supra*, these claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the

present invention over the references of record. Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. § 103 (a).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding objection and rejections, and an indication of the allowability of all the claims pending in the present application in due course.

**SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended claims for consideration by the Examiner. With respect to the pending claims, Applicant has eliminated the basis for the rejection. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and with respect to the claimed features argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment.

All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Kiyoshi TOYODA

William S. Boshnick

Reg. No. 44,550

A handwritten signature in black ink that reads "Will. Boshnick". The signature is written in a cursive style with a large, stylized "W" and "B".

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Bruce H. Bernstein  
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